

04-19-05

DAE
THU

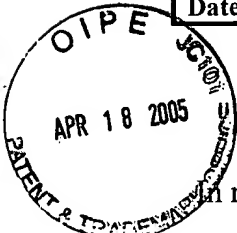
CERTIFICATE OF EXPRESS MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as Express Mail – Post Office to Addressee under Label No. **EV 567834844US** addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313

Date: April 18, 2005

Name: Elizabeth M. Swift

Signature: *Elizabeth M. Swift*



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Donald G. Russell

Serial No.: 09/372,835

Filing Date: August 12, 1999

For: **AN INTERMEDIATE DENSITY MARKER
AND A METHOD USING SUCH A MARKER
FOR RADIOGRAPHIC EXAMINATION**

)
) Examiner: Craig E. Church
)
) Confirmation No. 1878
)
) Art Unit: 2882
)
) Docket No. 97343.00005
)
)

Attn: Christine Donnell
Senior Petition Attorney
Office of Petitions
Mail Stop: Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

PETITION UNDER 37 CFR 1.182

Dear Sirs:

Applicant respectfully submits this Petition to assert that the application papers as originally filed are entitled to the filing date of August 12, 1999, and thus to the effective filing date of the grandparent application (serial no. 08/372,658) which is January 13, 1995.

The procedural history of this matter is as follows:

On August 10, 1999, Applicant submitted papers comprising the present application including 12 pages of specification, 5 pages of claims, 1 page of abstract, an Associate Power of Attorney, and a 3 page application transmittal identifying the application as a Continuation of prior application 09/934,121, and a check in the amount of \$419. The

04/20/2005 AWONDAF1 00000007 501402 09372835

01 FC:1462 400.00 DA

specification includes reference to drawing figures, but the drawing figures were unknowingly and mistakenly not included.

On September 3, 1999, the Office of Initial Patent Examination issued a Notice to File Missing Parts requiring submission of an executed oath or declaration.

On January 31, 2000, Applicant filed a Response to Missing Parts, with a Petition for 3-Month Extension of Time, a check in the amount of \$435, and an executed Declaration and Power of Attorney.

Thereafter, a Filing Receipt issued showing the Filing Date of August 12, 1999, and that this application is a continuation under 35 USC § 120 of parent application serial no. 08/934,121, now U.S. Patent No. 6,041,094.

In Office Actions dated May 9, 2000, November 21, 2000, and August 29, 2001, the Examiner noted "drawings are required". Applicant's attorneys understood this to mean that formal drawings were required, not that drawings were never filed.

On August 19, 2004, the Board of Patent Appeals and Interferences forwarded this case to the Office of Petitions, *sua sponte*, for a determination with regard to the appropriate filing date of the application and such further action as may be appropriate.

In the absence of a "Notice of Incomplete Application" prescribed by MPEP 601.01, Applicant fairly inferred that the application was considered to be entitled to the August 12, 1999, filing date. Upon receipt of the Order Forwarding the Application to the Office of Petitions and discussing same with the Senior Petition Attorney, Applicant has prepared and filed the present petition. Applicant therefore requests that this submission be considered by the Office of Petitions in its determination with regard to the appropriate filing date for the application.

This Application is entitled to the August 12, 1999 filing date, and thus an earliest effective filing date of January 13, 1995:

This application is entitled to retain the original filing date of August 12, 1999, notwithstanding omission of the drawings, because, under 35 USC § 113, first sentence, drawings are not required for the understanding of the invention.

Under 35 USC § 113, an “applicant shall furnish a drawing *where necessary* for the understanding of the subject matter sought to be patented” (emphasis added). The present invention is directed to a marker and a method for radiographic examination in which the marker comprises at least one partially radiolucent, partially radiopaque material defining a density and thickness that absorbs at least a specified amount of incident radiation, such that a radiographic image has a shadow of the marker superimposed thereon with anatomic detail present in the tissue clearly visible through the radiographic shadow projected by the marker. Applicant hereby asserts that, under 35 USC § 113, the application as filed is entitled to the filing date of August 12, 1999, because drawings are not necessary to the understanding of the invention claimed.

The invention claimed in this application is fully described in the specification as filed. Specifically, each feature recited in the claims is described at pages 6-12 of the specification as filed, and drawings are not necessary to the understanding of this subject matter.

MPEP 601.01(f) provides that:

[i]t has been USPTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 USC 113 (first sentence)... Other situations in which drawings are usually not considered necessary for the understanding of the invention under 35 USC 113 (first sentence) are:

....

(B) *Articles made from a particular material or composition*: where the invention consists in making an article of a particular material or composition, unless significant details of structure or arrangement are involved in the article claims;

....

(D) *Articles, apparatus, or systems where sole distinguishing feature is presence of a particular material*: where the invention resides solely in the use of a particular material in an otherwise old article, apparatus or system recited broadly in the claims...

The present application, as filed, contained claims 1-9 directed to a method of radiographic examination. Similarly, currently pending claims 20-61 include claims 20-45 and 54, directed to a method of radiographic examination, and claims 59-61, directed to a method of mammographic examination. As indicated in MPEP 601.01(f), an application having such claims is one for which a drawing is not necessary for understanding the invention under 35 USC § 113, and therefore should be entitled to a filing date without such drawings.

In addition, currently pending claims 46-53 and 55-58 are directed to radiographic markers, made of particular materials, without the recital of significant details of structure or arrangement. As indicated in paragraph (B) of MPEP 601.01(f), such an application is one for which a drawing is not necessary for understanding the invention under 35 USC § 113, and therefore may be entitled to a filing date without such drawings. Moreover, each feature recited in these article claims is explicitly disclosed at pages 6-12 of the specification as filed, and therefore drawings are not necessary to the understanding of this subject matter.

Accordingly, drawings are not necessary for the understanding of the subject matter of this application, per 35 USC § 113, and therefore the application is entitled to the filing date of August 12, 1999, and an earliest effective filing date of January 13, 1995.

The Drawings submitted herewith by Amendment are fully supported by the application as filed:

Applicant submits herewith an Amendment introducing Figures 1-7 of drawings, which are fully supported by the specification and claims of the application as originally filed.

37 CFR § 1.81(c) indicates that “[w]henver the nature of the subject matter sought to be patented admits of illustration by a drawing without its being necessary for the understanding of the subject matter and the applicant has not furnished such a drawing, the

examiner will require its submission....” Since the invention of the present application admits of illustration, but is such that a drawing is not necessary for the understanding of the subject matter, Applicant submits the enclosed Amendment and drawings in keeping with 37 CFR § 1.81.

Since Figures 1-7 of the drawings are fully supported by the specification and claims as filed, no new matter will be added by their inclusion in this case. The exemplary markers and methods of use illustrated in Figures 1-7 are fully described in the specification at pages 8-10, and the illustrations themselves add no new matter to the disclosure of this application. Accordingly, entry of the attached Amendment is respectfully requested.

Conclusion:

The Office is invited to contact Applicant’s attorney at the telephone and address below if any additional evidence or information may be required to resolve the matter presently before the Office.

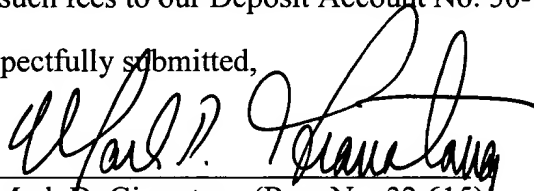
Authorization is hereby given to charge the Petition Fee of \$400.00 due under 37 CFR § 1.17(h) to our Deposit Account No. 50-1402. If any additional fee is required, or otherwise if necessary to remedy deficiency of fees already paid or refund excess of fees paid, authorization is hereby given to charge or credit such fees to our Deposit Account No. 50-1402.

Date:

18 April 2005

Respectfully submitted,

By


Mark D. Giarratana (Reg. No. 32,615)

McCarter & English, LLP

CityPlace I

185 Asylum Street

Hartford, CT 06103

Tel: (860) 275-6719

Fax: (860) 724-3397

HARTFORD: 636239.02

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the United States Postal Service on the date shown below with sufficient postage as Express Mail – Post Office to Addressee under Label No. **EV 567834844US** addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313

Date: April 18, 2005

Name: Elizabeth M. Swift

Signature: *Elizabeth M. Swift*

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Donald G. Russell

Serial No.: 09/372,835

Filing Date: August 12, 1999

For: **AN INTERMEDIATE DENSITY MARKER
AND A METHOD USING SUCH A MARKER
FOR RADIOGRAPHIC EXAMINATION**

)
) Examiner: Craig E. Church
)
) Confirmation No. 1878
)
) Art Unit: 2882
)
) Docket No. 97343.00005
)
)

Attn: Christine Donnell
Senior Petition Attorney
Office of Petitions
Mail Stop: Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313

TRANSMITTAL LETTER
TO SENIOR PETITIONS ATTORNEY CHRISTINE DONNALL

Dear Attorney Donnell:

Further to our previous telephone conversations, we submit herewith the following items:

1. a Petition under 37 CFR 1.182, asserting that the present application is entitled to the filing date of August 12, 1999, notwithstanding the unintentional omission of drawings from the papers as originally filed;
2. an Amendment, submitting Figures 1-7 of drawings to this application; and
3. a return receipt post card.

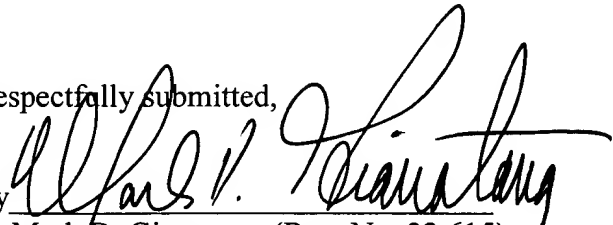
Authorization is herein given to charge any fees is required to our Deposit Account No. 50-1402.

Your advice and attention to this matter are greatly appreciated. If there are any questions or comments regarding this submission, please contact the undersigned attorney at the numbers below.

Date: 18 April 2005

Respectfully submitted,

By



Mark D. Giarratana (Reg. No. 32,615)

McCarter & English, LLP

CityPlace I

185 Asylum Street

Hartford, CT 06103

Tel: (860) 275-6719

Fax: (860) 724-3397

HARTFORD: 637937.01